



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/705,545 11/03/00 AYLWARD

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IM22/1026

PATENT LEGAL STAFF
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EXAMINER

SCHILLING, R

ART UNIT

PAPER NUMBER

1752

DATE MAILED:

10/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/705545

Applicant(s)

Ay/ward et al

Examiner

R L Schilling

Group Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-41 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-41 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit 1752

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, 19 and 21 are rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by Tingler '014. Tingler et

Art Unit 1752

(A) al. '014 (see particularly column 1, lines 18-30; column 4, lines 30-65; column 5, lines 1-10; column 8, lines 8-67; Examples 1-4; column 10, lines 16-21 and lines 62-68) disclose silver halide elements comprising polyurethane overcoats on anti-static backing layers on transparent polymer sheets. Example 1 in Tingler et al. uses anti-static layer compositions and protective layer compositions substantially the same as those used in Example 1 of applicants' specification on the side of a transparent polyester support opposite from silver halide emulsion layers.

2. Claims 1-17, 19 and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tingler et al. '505. Tingler et al. '505 (see particularly column 2, lines 5-33; column 10, line 5 - column 11, line 10; Examples 1-6) discloses photographic elements with transparent polymer supports having anti-static backing layers and protective layers over the anti-static backing layers.

3. Claims 1-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Trautweiler et al., Tingler et al. '014 and Tingler et al. '505. Trautweiler et al. (see particularly column 5, lines 7-61) discloses photographic elements with thin transparent polymer supports which are adhered to base materials after exposure and processing. Tingler et al. '014 and Tingler et al. '505 discloses the need for anti-static

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Art Unit 1752

layers on the opposite side of supports from silver halide emulsion layers in order to prevent static generation from film handling and processing. ^{A could have also} Therefore, it would be obvious to one skilled in the art to use anti-static backing layers on the photographic films of Trautweiler in order to prevent the generation of static electricity. It would also be obvious to one skilled in the art to use the protective backing layers as in Tingler et al. '014 and Tingler et al. '505 on these anti-static layers in order to protect them during processing, prevent abrasion and reduce friction.

4. Claims 1, 2, 4-8, 13-17 and 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oltean et al. Oltean et al. (see particularly column 5, lines 46-68; column 3, lines 15-33; column 7, line 64 - column 8, line 36) discloses silver halide photographic elements with lubricating and anti-abrasion protective layers on the sides of a transparent polymer support opposite from silver halide emulsion layers. The supports have thicknesses preferably 85-125 microns.

5. Claims 1, 2; 4-17 and 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murayama. Murayama (see particularly column 1, lines 36-51; column 13, line 35 - column 14, line 43; the Example) discloses silver halide photographic

Art Unit 1752

elements with transparent polyester supports of 90 microns thick with backing layers of anti-static and lubricant and anti-abrasion protective layers.

6. Claims 1-8, 13, 14, 16, 17 and 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ueda et al. Ueda et al. (see particularly column 2, lines 1-35; column 2, lines 59-69; column 6, lines 15-44; Examples 1 and 3) disclose silver halide photographic elements with transparent polyester supports less than 100 microns thick having backing layers.

7. Bourdelais et al. '547 is cited of interest in the art as disclosing photographic elements with thin transparent polymer supports which are adhered to base sheets. Richman et al. is cited of interest in the art as disclosing the use of anti-halation layers over silver halide emulsion layers. Greener et al. is cited of interest in the art as disclosing extruded anti-static layers. Fukazawa is cited of interest in the art as disclosing supports for photographic elements of 25-120 microns. Coltrain et al., Nair et al. '541 and Hashimoto et al. are cited of interest in the art as disclosing protective layers over anti-static backing layers in silver halide photographic elements. The prior art submitted by applicants has been considered.

8. Claims 7 and 24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly

Serial No. 09/705,545

-6-

Art Unit 1752

point out and distinctly claim the subject matter which applicants regard as the invention. The term "may be selected from" in claims 7 and 24 makes these claims indefinite as to whether or not the Markush members are required.

9. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (703) 308-4403.

RLSchilling:cdc

October 22, 2001

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1100 1752

